

**Remarks/Arguments:**

Applicants would like to thank the Examiner for the courtesy of the telephonic interview with their undersigned representative on August 18, 2009. A summary of that discussion has been made of record in the case. Because no agreement was reached with respect to the claims, Applicants now file this reply and respectfully request reconsideration of the rejections currently outstanding with respect to the pending claims.

Upon entry of the amendment, claims 29-42 will be pending. New claim 42 is presented herewith and combines elements of claims 29 and 38. Thus, no new matter has been added. Applicants address the Examiner's rejections below.

***Summary of Invention***

It is generally known that isophthalic acid rich polyesters result in powder coatings that have outstanding outdoor durability, yet poor flexibility. Applicants have discovered, as indicated by the claimed invention and as detailed by the instant specification, that coating flexibility can be obtained for an isophthalic acid rich polyester when the polyester incorporates a specific selection of polyols. *See* US Publication No. 2006/0217520, paragraphs [0017]-[0018]. Additionally, when the isophthalic acid rich polyester is formulated with a  $\beta$ -hydroxyalkylamide hardener, outstanding degassing properties are also obtained. *See id.* Thus, the instant application and claimed invention teach the particular formulation required for an isophthalic acid rich polyester having: i) outstanding degassing properties, ii) outstanding weatherability, and iii) improved flexibility. *See id.* at paragraph [0084].

By comparison, powders composed of terephthalic acid rich polyesters and various polyols have good flexibility, but do not score as well on the visual aspect (Orange Peel). *See id.* at paragraphs [0074]-[0077] and Example 15 of Table 2. Furthermore, powders composed

purely of isophthalic acid and various other polyols have problems with orange peel and lack flexibility as measured by direct and reverse impact strength. *See id.*, and Example 16 of Table 2.

Accordingly, the claimed invention recites powdered thermosetting compositions comprising: a) a carboxyl functional amorphous polyester with an acid number ranging from 12 to 34 mg KOH/g, wherein the polyester is prepared from:

- i) a polyacid constituent comprising from 81 to 100% mol of isophthalic acid, and
- ii) a polyol constituent comprising from 15 to 65% mol of one or more linear chain aliphatic C<sub>4</sub>-C<sub>16</sub> diol, and from 35 to 85% mol of neopentyl glycol,

and

- b) a cross-linking agent comprising at least two  $\beta$ -hydroxyalkylamide groups

with the proviso that said powdered thermosetting composition does not contain a semi-crystalline polyester.

*Moens does not anticipate the instant claims because it does not disclose the range of polyols recited by the claimed invention with sufficient specificity.*

While there is a partial overlap between the range of polyols disclosed in Moens and of the claimed invention, Applicants contend that Moens does not disclose the claimed range of polyols with sufficient specificity to uphold the anticipation rejection. Applicants rely on MPEP 2131.03 (II) and *Atofina v. Great Lakes Chemical Corp.* 441 F.3d 991, 78 USPQ2d 1417 (Fed. Cir. 2006) in support of their position.

In *Atofina*, the Federal Circuit ruled that a prior art reference disclosing a temperature range of 100 to 500° C, and a preferred range of 150 to 350°C, did not disclose with sufficient

specificity a claimed range of 330 to 450° C. *See Atofina* 441 F.3d at 998-1000; 78 USPQ2d at 19-25. In its decision, the court stated that it was a well established principle of patent law that the disclosure of a genus in the prior art is not necessarily a disclosure of every species that is a member of that genus. *See id.* at 999; 21. The court further noted that while the prior art disclosed a range (150 to 350° C) that slightly overlapped with the claimed range (330 to 450° C), the slightly overlapping range is not disclosed as a species of the claimed generic range of 330 to 450° C, and that the disclosure of a range of 150 to 350° C is not a specific disclosure of the endpoints of that range, or of each of the intermediate points. *See id.* at 1000; 23.

Similarly, in the instant application Moens has been cited for disclosing an isophthalic acid rich amorphous polyester that contains, in relevant part, from 70 to 100 mol % of neopentyl glycol (NPG) and from 0 to 30 mol % of an aliphatic and/or cycloaliphatic polyol. However, the claimed invention recites an isophthalic acid rich amorphous polyester that contains from 35 to 85 mol % NPG and 15 to 65 mol % of a linear chain aliphatic polyol. Thus, of the 50 point range of NPG and aliphatic polyol claimed by the instant invention only 15 points overlap with the range disclosed by Moens. More importantly, the slightly overlapping range is not disclosed as a species by Moens, nor has Moens specifically disclosed any of the intermediate points in the claimed range.

Accordingly, since each and every element of the claimed invention is not disclosed by Moens, the reference cannot be said to anticipate the claimed invention. Withdrawal of the rejection is respectfully requested.

*The combination of Kaplan in view of Moens is improper and insufficient to establish a prima facie case of obviousness.*

An obviousness determination requires factual inquiries into the scope and content of the prior art, the level of ordinary skill in the art, the difference between the claimed invention and the prior art, and any objective evidence of non-obviousness such as those demonstrated by secondary consideration. *See, e.g., Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966). In order to render a claimed invention obvious, the prior art must enable one skilled in the art to make and use the claimed invention. *See Motorola Inc. v. Interdigital Tech. Corp.*, 43 USPQ2d 1481, 1489 (Fed. Cir. 1997). Furthermore, the cited references must be read as a whole and consideration must be given where the references diverge and teach away from the claimed invention. To pick and choose among individual parts of assorted prior art references as a mosaic to recreate a facsimile of the claimed invention is improper. *See e.g., Akzo N.V. v. United States Int'l Trade Comm'n*, 1 USPQ2d 1241, 1246 (Fed. Cir. 1986) *cert denied*, 482 U.S. 909, (1987); *see also* MPEP § 2141.02, part VI.

The Examiner acknowledges that Kaplan does not disclose the exact composition of amorphous polyester as claimed in claim 20 (now claim 29). *See* Office Action mailed May 7, 2009 at page 6. Applicants concur and further submit that the reference is not enabling for (*i.e.*, does not teach) an isophthalic-rich carboxyl functional amorphous polyester as required by the claimed invention. Only Example 3 of Kaplan relates to a carboxy-functional amorphous polyester. However, this example teaches a *terephthalic* acid-rich polyester.

While Kaplan provides a laundry list of suitable alcohol components ranging from C<sub>2</sub>-C<sub>20</sub>, the linear chain aliphatic C<sub>4</sub>-C<sub>16</sub> diols, as required by the claimed invention, are not

especially highlighted for use, nor is the concentration in which they should be used disclosed. Accordingly, even if the references were properly combinable (but they are not), the combination still would not lead to the claimed invention as neither reference teaches the recited range of polyols.

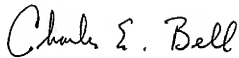
Applicants additionally contend that the combination of Kaplan and Moens is improper on its face because Moens, viewed as a whole, requires a polyester composition having both a semi-crystalline polyester and an amorphous polyester. *See Moens* at Abstract; *see also* col. 8, lines 52-57; col. 19, lines 1-17; and claim 1. However, the claimed invention recites an isophthalic acid rich amorphous polyester without a semi-crystalline polyester present. Thus, one of skill in the art relying on the combination of Moens and Kaplan would have been led in a path divergent from that solved by the claimed invention. Furthermore, Moens would have been rendered unsatisfactory for its intended purpose, because Moens specifically discourages isophthalic acid rich amorphous polyester compositions for use in coatings due to their “medicare [sic, mediocre] mechanical properties,” such as flexibility *See Moens*, col. 19, lines 10-16.

*Arguendo*, even if a *prima facie* case of obviousness has been established, the instant specification contains evidence of unexpected and/or superior results sufficient to rebut the case, as detailed above at page 6, *supra*.

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and withdrawal of the rejection.

With a Petition for a two month extension of time and payment of the corresponding fee, this paper is due on or before October 7, 2009. The Commissioner is hereby authorized to charge payment of any additional fees that may be required, or credit any overpayment of same, to Deposit Account No. 03-4083.

Respectfully submitted,



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Charles E. Bell, Reg. No. 48,128  
Attorney for Applicants  
CYTEC INDUSTRIES INC.  
Telephone: (203) 321-2200  
Facsimile: (203) 321-2971  
Customer Number 08015